



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

STEPHEN B. AUGER

Serial No. 09/932,976

Art Unit: 1751

Filed: August 21, 2001

Examiner: M. Einsmann

For: MINERAL STAINS FOR WOOD AND OTHER SUBSTRATES

#4
2-4-02

RESPONSE

To the Commissioner of Patents and Trademarks

Sir:

RECEIVED
JAN 31 2002
TC 1700

In response to the Office Action dated January 4, 2002,
kindly consider the following:

Applicant provisionally elects Group II drawn to the method,
with traverse. Claims 2-22 and 53-56 read on the elected
species.

Reconsideration and withdrawal of the election requirement
are requested.

The claims of Groups I, II and III do not relate to
materially different kits, products or processes. The method
defined by Group II relates to the kit, per se, described in the
claims of Group I and the product of Group III.

They are not related to materially different processes that
would result in a kit used for different purposes nor can they be
used to practice a different process than that intended and
claimed.

The inventions as described in the claims are neither

independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus (kit) used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon a holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed inventions:

are able to support separate patents and they are ...
distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it

on the merits, even though it includes claims to distinct or independent inventions.

So that Section 803 makes its point clearly, the serious burden requirement is repeated under the title:

CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS

Section 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES an that examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner. The examiner in this case is a senior examiner and is well skilled in the cited Class and Subclasses therein.

The subclasses the examiner has cited are all close together and are all within the subclasses which the examiner regularly searches, and all require routine searching and indeed are listed together under each other in the classic outline form. Indeed, it would not be unreasonable for the examiner to search subclasses that are close together. Therefore restriction should not be required.

For instance, the claims clearly define the kit of Group I being the basis for the method of Group II to produce the product of Group III. Such a kit cannot have the different applications

or the different processes contemplated by the examiner.

For the above reasons, the Applicant believes that the claims should be examined together. Hence, the Examiner should kindly withdraw the restriction and consider all the claims, 1-56, together.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the requirement are respectfully requested.

Respectfully,



James C. Wray, Reg. No. 22,693
Meera P. Narasimhan, Reg.No. 40,252
1493 Chain Bridge Road, Suite 300
McLean, Virginia 22101
Tel: (703) 442-4800
Fax: (703) 448-7397

January 29, 2002